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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/321,633	05/28/1999	JAMES W. KENNEY	E-1901	6762

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EXAMINER

BEX, PATRICIA K

ART UNIT PAPER NUMBER

1743

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/321,633

Applicant(s)

KENNEY, JAMES W.

Examiner

P. Kathryn Bex

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-17, 23-27 and 35-42 is/are allowed.
- 6) ☒ Claim(s) 1-14, 18-22, 28, 29, 31-34 and 43 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

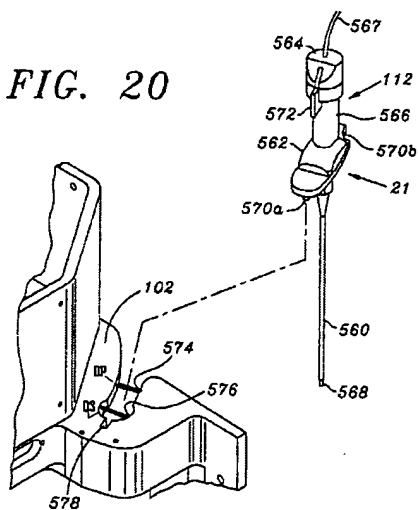
1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 1-14, 22, 28-29 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (USP 5,090,255) in view of Goodale *et al* (USP 5,356,525).

Kenney teach a pipette gun 17 having a remote source of air pressure 55 with an external flexible air conduit, a housing with hand grip portion, a barrel portion, a pipette connector 23 oriented transverse to the barrel portion 21, an internal conduit 61, a valve 31 intermediate the internal conduit, a positive 27 and negative 25 air flow trigger connected to the valve, and a on/off switch 63 for regulating the flow of power to the remote air source (Fig. 1). Kenney teaches the switch such that the operator turns on the pipette apparatus when the dispensing procedure begins (claim 1). Given this teaching, it would be obvious to one of ordinary skill that the power switch is turned off after the operator is done using the pipette apparatus.

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Additionally, this switch, through the microprocessor 43, automatically activates/deactivates the air pressure source. Kenney fails to teach a gun holster arranged to support the gun above the worktable. Goodale *et al* teach a pipette holster used to support the pipette 112 above a worktable in a vertical direction. Goodale *et al* teach a mounting bracket 102 having a fork with prongs 574 and a circular socket 576 constructed to removably hold the pipette. Wherein the socket is formed between the prong and has a diameter (DS) which is larger than the distance between the prongs (DP), (column 11, line 61- column 12, line 28, and modified Fig. 20 below.) The opening 576 is smaller in diameter than the head 564 such that the pipette probe 112 may be supported by the head 564 within the opening 576, the key 572 and keyway 578 cooperating to align the pipette probe 112 within the opening 576 and thus with respect to the frame 102. Such use of a bracket insures that the pipette tube does not touch anything and will remain sterile. Given this teaching, it would be obvious to one of ordinary skill that the pipette connector 564 and barrel 566 is inserted from the top such that it engages the socket 576.

FIG. 20



Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included in the dispensing means of Kenney, the pipette holster, as taught by Goodale *et al* in order to insure that the pipette tube does not touch anything and will remain sterile while remaining securely restrained within the mounting bracket (column 2, lines 35-57 of Bale *et al* (USP 5,704,495)).

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With respect to the shape of the external conduit, it would have been obvious to one of ordinary skill in the art to coil a portion of the external conduit of Kenney, in order prevent most of the conduit from touching the table and possibly knocking over lab equipment on the table.

Although Goodale *et al* does not specifically recite the base of the holster attached to a vertical wall, it would have been obvious to attach the base of the mounting bracket to a vertical wall in order to provide a stable surface of attachment. Additionally, with respect to the specific attachment means, it would have been an obvious matter of design choice to use suction cups, Velcro tabs or magnets. Since applicant has not disclosed that these specific fastening means solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the fixing means taught by Bale *et al*.

With respect the mounting bracket comprising a pair of forks, it has been held that the mere duplication of parts has no patentable significance unless a new and unexpected is produced. *In re Harza*, 124 PQ 378 (CCPA 1960).

4. Claims 18-21, 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (USP 5,090,255) in view of Goodale *et al* (USP 5,356,525) as applied to claim 1 above, and further in view of Nycum (USP 4,066,234).

Kenney and Goodale *et al* as discussed above, fail to teach a mounting pad for the air pressure source. Nycum teaches a universal mounting pad 11 with plurality of bores 28-29 for accepting structures 24-25 on equipment 10 and 30 (Figs. 1-2). Such a mounting pad is used for protecting fragile equipment against shock and vibration (abstract). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included in the

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dispensing means of Kenney and Goodale *et al*, the mounting pad, as taught by Nycum, in order to insure protection fragile pump equipment against shock and vibration.

***Allowable Subject Matter***

5. Claims 15-17, 23-27, 35-42 are allowed.
6. Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. The following is a statement of reasons for the indication of allowable subject matter:  
See previous Office Action.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-14, 18-22, 28-34, 43 have been fully considered but they are not persuasive. In response to the previous rejection of claims 1-14, 22, 28-29 and 43 under 35 U.S.C. 103(a) as being unpatentable over Kenney (USP 5,090,255) in view of Goodale *et al* (USP 5,356,525), Applicant argues Goodale *et al* do not teach inserting the pipette connector into the socket through the top so that the pipette connector engages the socket, since Goodale *et al* teach the insertion of the pipette barrel portion 566 of the pipette probe 122 into the opening 576, not the pipette connector. Examiner does not agree, since Examiner relies on Kenney for the teaching of the pipette gun 17 having a housing with hand grip portion, a barrel portion, a pipette connector 23 oriented transverse to the barrel portion 21. The rejection is based on the combination of Kenney's pipette with the holster of Goodale *et al*, which is capable of holding a pipette. Therefore, would have been obvious to one of ordinary skill in the art to insert Kenney's pipette into the holster or Goodale *et al*, in order to insure that the pipette

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tube does not touch anything and will remain sterile while remaining securely restrained within the mounting bracket. Moreover, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

9. Claims 1-14, 22, 28-29 and 43 are rejected. Claim 30 is objected to. Claims 15-17, 23-27, 35-42 are allowed.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays, alternate Fridays from 6:00 am to

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3:30 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 308-4037.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9310 for official papers prior to mailing of a Final Office Action. For after-Final Office Actions use (703) 872-9311. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

*Kathryn Bex*

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May 5, 2003

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